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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/923,369	09/03/1997	SHIGEAKI KOIKE	SONY-C5757	2545

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EXAMINER

BOCCIO, VINCENT F

ART UNIT PAPER NUMBER

2615

DATE MAILED: 07/01/2004

#34

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

08/923,369

Applicant(s)

KOIKE ET AL.

Examiner

Vincent F. Boccio

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 April 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 10,12,13,16, 25 and 28-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 10,12,13,16,25 and 28-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☒ Certified copies of the priority documents have been received in Application No. 08/563,188.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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DETAILED ACTION
Response to Arguments

1. Applicant's arguments filed 4/8/04 have been fully considered but they are not persuasive.

{A} In re page 1, applicant states, "Neither Lang, Takada or Honjo disclose the arrangement claimed in claim 10".

2. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

{B} In re page 1-2, applicant states, Lang ... does not disclose a signal processor for switching, between the Digital tape recording means, the analog video input means, and the digital transfer circuit. Further to point out the elements of Lang that read on claim 10.

In response the examiner fails to agree.

Since Lang in Fig. 2, elements 12, 13, 34 and 14, also Fig. 3, elements 12, 13, 34 and 14, provides all the functionality, routing as recited and reads on the claimed elements, as claimed.

The examiner suggests, to recite in the claims, more detail of what is not included these elements,

{A} transfer circuit;

{B} processor;

{C} digital interface;

to provide a distinction, as being separate, independent and distinct elements, thereby claiming what is

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not included rather, in addition to what is included, seems required to utilizing some language to negate, some functions or elements, to distinguish the claims from the prior art, as applied.

{C} In re page 2, applicant states, "Honjo teaches nothing regarding a digital tape recording means and disc recording means, and the various components of claim 10.

In response Honjo is provided for the teaching of buffering only.

Further, as one skilled in the art would understand, Honjo teaches buffering to and from a disk, in view of the ability to recording and reproduce at rates higher than real time, thereby controlling buffering based on the ability of the disk to record and reproduce at high data rates.

Further Honjo is not relied upon for any teaching associated with a tape recorder.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

2. Claims 10, 12-13, 16, 25 and 28-30 are rejected under

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35 U.S.C. 103(a) as being obvious over Lang (US 5,164,839) in view of Takada et al. (US 5,715,104) and Honjo (US 5,432,769).

Since no amendment to the claims the examiner incorporates by reference the previous actions against the claims, as analyzed and discussed previously.

Conclusion

3. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Contact Fax Information

Any response to this action should be mailed to:
Commissioner of Patents and Trademarks
Washington, D.C. 20231

or faxed to:

(703) 872-9314, (for formal communication
intended for entry)

or:

(703) 308-5359, (for informal or draft
communications, please label "PROPOSED" or
"DRAFT")

Hand-delivered responses should be brought to
Crystal Park II, 2121 Crystal Drive,
Arlington, VA., Sixth Floor
(Receptionist).

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Contact Information

1. Any inquiry concerning this communication or earlier communications should be directed to the examiner of record, Monday-Thursday, 8:00 AM to 5:00 PM Vincent F. Boccio (703) 306-3022.

If any attempts to reach the examiner by telephone are unsuccessful, the examiners supervisor, Andy Christensen (703) 308-9644.

Any inquiry of a general nature or relating to the status of this application should be directed to Customer Service (703) 306-0377.

Primary Examiner, Boccio, Vincent
6/28/04


VINCENT BOCCIO
PRIMARY EXAMINER